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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,170	12/30/2005	Hanno Syrbe	P2917US00	9281
30671 7590 09/02/2009 DITTHAVONG MORI & STEINER, P.C. 918 Prince St. Alexandria, VA 22314				
EXAMINER				
CASCA, FRED A				
ART UNIT		PAPER NUMBER		
2617				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/539,170

Applicant(s)

SYRBE, HANNO

Examiner

FRED A. CASCA

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to applicant's amendment filed on 08 June 2009. Claims 1-3 and 5-27 are still pending in the present application. **This Action is made FINAL.**

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 1-3, 7-8 and 13-16, 19-21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka (US 6,477,461 B2) in view of Veerasamy et al (US 2004/0203855) and further in view of Marwell et al (2002/0196922).

Referring to claim 1, Tanaka discloses a method for creating a collection of selected geographical positions (abstract and figures 1-2, col. 3, lines 11-20) using a mobile terminal having a geographical position system (abstract, col. 2, lines 59-67, and figure 1, "vehicle", "navigation system for a vehicle", note that the navigation system for the vehicle is mobile) and a memory for containing the collection of selected geographical positions (abstract, col. 1, lines 55-60, col. 2, lines 60-67, "memory"), the method comprising:

automatically obtaining or determining the current geographical position of the mobile terminal using information received from the geographical position system (figures 3-8, col. 2, lines 59-

67, “for detecting the present position”, “GPS”, note that calculations in determining the address is done automatically. Further, any information used in the determining process is a information received form geographical position system); and storing the obtained position in the memory upon a user input (abstract and col. lines 18-54, “when a user inputs a new location for registration, data of an input new location is stored in the rewritable memory”),

wherein said mobile terminal has a plurality of operating modes including one recording mode (abstract, col. 1, lines 55-60, col. 2, lines 60-67).

Tanaka does not specifically disclose storing the current geographic position in the memory upon detection of an input to store the current position as claimed.

Veerasamy discloses mobile station and storing the geographic location in the memory (Par. 7 and 11).

It would have been obvious to one of the ordinary skill in the art at the time of invention to modify the method of Tanaka in the format claimed for the purpose of providing an efficient geographical navigational system.

The above combination does not disclose the mobile terminal has a single key activation on the mobile terminal causes the current geographical position to be stored.

Marwell discloses a mobile terminal having a single key activation on the mobile terminal that causes information to be stored.

It would have been obvious to one of the ordinary skill in the art at the time of invention to modify the method of Tanaka in the format claimed for the purpose of providing an efficient geographical navigational system.

Referring to claim 2, the combo of Tanaka/Veerassamy/Marwell discloses the method according to claim 1, further comprising the step of adding an attribute to the saved geographical position (abstract and figures 1-2, col. 3, lines 5-20, “travel route”).

Referring to claim 3, the combo of Tanaka/Veerassamy/Marwell discloses a method according to claim 1 wherein the mobile terminal comprises at least one key and the user input to store a preset geographical position in the memory is carried out by pressing only one (inherent) the at least one key (figure 1, 9-10, inherent).

Referring to claim 7, the combo of Tanaka/Veerassamy/Marwell discloses the method according to claim 1 wherein the mobile terminal is provided with means for communicating data to other terminals, further comprising the step of the mobile terminal sending geographical positions stored in the memory to other terminals and/or receiving geographical positions from other terminals (figure 1, “11”, note that information sent among mobile users via SMS and voice including geographic information is inherent in mobile communication).

Referring to claim 8, the combo of Tanaka/Veerassamy/Marwell discloses the method according to claim 7, wherein the mobile terminal has an RF or IR receiver/transmitter (inherent), further comprising the step of sending and/or receiving geographical positions via an RF or IR based communication channel (figure 1, GPS receiver).

Referring to claim 13, the combo of Tanaka/Veerassamy/Marwell discloses the method according to claim 1 wherein “the attribute” comprises a time and date stamp and/or a sound file, and/or an image file (inherent), and or a motion video file, and/or a text file (figure 9-16).

Referring to claims 14-16 and 19-20, claims 14, 15, 16, 19 and 20 define a mobile terminal reciting features analogous to the features of the method of claims 1, 2, 4, 7 and 8 (as rejected above). Thus, the combo of Tanaka/Veerassamy/Marwell discloses all elements of claims 14, 15, 16, 19 and 20 (please see the rejection of claims 1, 2, 4, 7 and 8 above).

Referring to claim 21, the combo of Tanaka/Veerassamy/Marwell discloses the mobile terminal according to claim 14 wherein the means for storing a current geographical position in the memory upon a user input is a software application on the mobile terminal (Figures 1-3 5 and 9-14, note that means for storing any data in memory is inherently a software application).

Referring to claim 23, claim 23 define a mobile terminal and an application reciting features analogous to the features of the method of claim 1 (as rejected above). Thus, the combo of Tanaka/Veerassamy/Marwell discloses all elements of claim 23 (please see the rejection of claim 1 above).

4. Claim 5, 6, 12, 17-18 and 22 and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka (US 6,477,461 B2) in view of Veerasamy et al (US 2004/0203855) and further in view of Marwell et al (2002/0196922) in view of well known prior art (MPEP 2144.03).

Referring to claim 5, the combo of Tanaka/Veerassamy/Marwell discloses the method according to claim 1, wherein the mobile terminal has means for performing mathematical operations.

Tanaka does not specifically disclose the step of performing statistical and/or probability analysis on the collection of geographical positions.

Examiner takes official notice of the fact using statistical and or probability analysis on the collection of geographical positions is well known in the art.

It would have been obvious to one of the ordinary skill in the art at the time of invention to modify the method of Tanaka by incorporating the well known concepts for the purpose of providing an efficient geographical navigational system.

Referring to claim 6, the combination of Tanaka/Veerasingam/Marwell and well-known art discloses the method according to claim 5, and further discloses the analysis preferably comprises analysis of area related density of geographical positions (well known), preferably selectively within geographical positions with a given attribute or with attributes within a given group (well known).

Referring to claim 12, the combination of Tanaka/Veerasingam/Marwell discloses the method according to claim 5 and further discloses the step of generating a map for illustrating the result of the statistical and/or probability analysis, preferably by generating and displaying a map of an area (inherent) with a given density or density range of geographical positions with a given attribute or with attributes within a given group (also see figures 9-16 and the corresponding paragraphs).

Claims 17, 18 and 22 are analogous to claims 5, 6 and 12. Thus they are rejected for the same reasons that claims 5, 6 and 12 are rejected.

Claims 24-27 are rejected for the same reasons that claims 5-6, 12 and 22 are rejected.

5. Claim 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka (US 6,477,461 B2) in view of Veerasamy et al (US 2004/0203855) and further in view of Marwell et al (2002/0196922) in view of Najafi (US 2004/0203843 A1).

Referring to claim 9, the combo of Tanaka/Veerasamy/Marwell discloses the method according to claim 8.

The combo of Tanaka/Veerasamy/Marwell does not specifically disclose the mobile terminal is a mobile phone or a communicator for use in a wireless cellular communication network and capable of sending and receiving text messages, further comprising the step of sending a text message including at least one geographical position from the memory, preferably including any associated attribute of the geographical position concerned, to one or more remote terminals.

Najafi discloses a mobile phone capable of sending and receiving text messages, which includes a location determination device and the location information can be transmitted as text (figures 1-2, abstract and paragraph 15).

It would have been obvious to one of the ordinary skill in the art at the time of invention to modify the method of Tanaka by incorporating the teachings of Najafi into that of Tanaka in the format claimed by applicant, for the purpose of providing convenience for users since a user

then will use only one multi-purpose mobile phone that performs both location determination and telephone calls as well.

Referring to claim 10, the combo of Tanaka/Veerassamy/Marwell/Najafi disclose the method according to claim 9, and further disclose that one or more remote terminals are mobile phones or communicators, and one of the mobile phones or communicators functions as a server with a database of geographical positions (Tanaka, figure 1 and Najafi, figure 1).

Referring to claim 11, the combo of Tanaka/Veerassamy/Marwell discloses the method according to claim 8.

Tanaka fails to disclose connecting to a cellular network as claimed by applicant.

Najafi discloses connecting a terminal with location determination features to a cellular network (fig. 1-2, paragraphs 15-16, 22, 24, 27).

It would have been obvious to one of the ordinary skill in the art at the time of invention to modify the method of Tanaka by incorporating the teachings of Najafi into that of Tanaka in the format claimed by applicant, conserving energy and efficient RF resource usage.

Response to Arguments

6. Applicant's arguments with respect to claims 1-3 and 5-27 have been considered but they are not persuasive.

In response to applicant's arguments that "Tanaka does not disclose or suggest creating a collection of selected geographical positions using a mobile terminal as is claimed by Applicant"

the examiner respectfully assets that the recitation [creating a collection of selected geographical positions using a mobile terminal] has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Further, Tanaka's disclosure of "displaying a map including the present location and a travel route" reads on the aforementioned recitation in the preamble of the applicant's independent claims (see Tanaka, col. 3, lines 5-6).

In response to arguments that Tanaka does not disclose "automatically" obtaining or determining the current geographical position," the examiner respectfully disagrees. The GPS receiver of Tanaka automatically determines the current position. A person of ordinary skill in the art would understand that the GPS calculations are performed automatically (see Tanaka, col. 2, line 63).

In response to arguments that Veerasamy does not disclose "creating a collection of selected geographical positions as is claimed by Applicant," the examiner respectfully assets that the recitation [creating a collection of selected geographical positions using a mobile terminal] has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the

preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

In response to arguments that Combining Marwell with Veerasamy also does not disclose “determining a current geographical location of the mobile station and creating a list of geographical positions as is claimed by Applicant,” the examiner asserts that the limitation, “determining a current geographical location of the mobile station and creating a list of geographical positions,” is disclosed in Tanaka (see Tanaka, col. 2, line 60-col. 3, line 20). Further, it is noted t features upon which the applicant relies (e.g., creating a list of geographical positions) are not cited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *in re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to arguments that there is no motivation to combine Tanaka, Veerasamy and Marwell, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the examiner disagrees with the applicant because all three references are within the scope of location determination of wireless device.

Veerasamy discloses the location determination concepts in paragraph 9 using GPS receivers obtaining location information for a mobile terminal. Veerasamy further discloses storing the geographic location in the memory (Par. 7 and 11).

Marwell also discloses operations of a mobile terminal in a cellular network (Fig. 1-3). Further, the limitation of storing information by pressing a single key in a mobile terminal is conventional in the art of mobile communication. Thus, it would have been obvious to a person of ordinary skill in the art to combine the Veerasamy and Marwell with Tanaka. Further, providing the storing feature of Veerasamy and Marwell would allow a user store the location information so that the stored location can be accessed easily again if need, thus, combining Veerasamy and Marwell with Tanaka would provide an efficient communication system.

In response to arguments that “Tanaka, Veerasamy and Marwell have not been properly combined because if Tanaka were able to modified by Veerasamy and Marwell, Tanaka would no longer be fit for its intended purpose,” the examiner respectfully asserts that features may be added to the basic subject matter which do not change the character thereof, but do perfect it for its intended purpose; e.g., in this case adding the storing element by a pressing of a key which is conventional in the art would not change the scope of the claim but it would make it better.

Applicant’s arguments with respect to claims 9-11 stating that “neither Tanaka nor Najafi are analogous art and cannot be combined for purposes of 35 USC 103(a) when applying the reasoning noted above” has been considered but they are not persuasive. The examiner asserts that the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some

teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Najafi clearly discloses a location determination method e.g., using a GPS, where a mobile phone has a GPS receiver for determining its location. Najafi further discloses a sending and receiving text message which includes a location determination device and the location information can be transmitted as text (see figures 1-2, abstract and paragraph 15). Thus, Najafi is clearly is an analogous art and a person of ordinary skill in the art would be able to combine Najafi with Tanaka.

Conclusion

7. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred A. Casca whose telephone number is (571) 272-7918. The examiner can normally be reached on Monday through Friday from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Harper, can be reached at (571) 272-7605. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/FRED CASCA/

Patent Examiner, Art Unit 2617

/VINCENT P. HARPER/

Supervisory Patent Examiner, Art Unit 2617